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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,765	03/10/2004	Daniel Oas	SS-133	6409
35693	7590	05/23/2006		
THE SONI LAW FIRM 55 S. LAKE AVE SUITE 720 PASADENA, CA 91101			EXAMINER WALCZAK, DAVID J	
			ART UNIT 3751	PAPER NUMBER

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/798,765

Applicant(s)

OAS, DANIEL

Examiner

David J. Walczak

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election***

Applicant's election without traverse of Group I in the reply filed on 4/4/06 is acknowledged. Claims 1-17 are readable thereon and will be examined herein. Claims 18-23 are hereby withdrawn from further consideration.

### ***Abstract***

The abstract of the disclosure is objected to because phrases that can be implied, such as "is disclosed" and "Also disclosed" (see lines 1 and 9) should not be present therein. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoenig. In regard to claims 1 and 8, Hoenig discloses a writing instrument comprised of a writing instrument body 5, 9, a light source 28 electrically connected with a power supply 33 and a switch 30, 35, an ink reservoir 12 in proximity to the light source and containing ink in fluid communication with a pen tip 16 and a light

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conducting member 25, 24 in luminescent communication with the light source and protruding downwardly into the reservoir 12 (see Figure 3) wherein the light conducting member illuminates the ink the reservoir. In regard to claim 6, the light source is a light bulb 28. In regard to claim 9, the light source, power supply and switch are housed in an upper section and the ink reservoir and light conducting member are housed in a lower section wherein the two sections are connected. In regard to claim 12, the light conducting member is connected in proximity to the light source and light from the light source is directed generally into the central vertical axis of the reservoir.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 10, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoenig. In regard to claims 2, 3, 10 and 11, although the Hoenig reference does not disclose that the reservoir is formed from material that is at least partially transparent/translucent, the Examiner takes official notice that such ink reservoirs are commonly formed from such material in order to enable a user to view the contents of the reservoir (in order to determine the amount of ink remaining therein). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to form the reservoir 12 in the Hoenig device from such a material in order to enable a user to view the contents therein. In regard to claims 4 and 13-15, although the Hoenig reference does not disclose the particular type of ink in the reservoir or the particularly claimed tip, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the Hoenig device can be equipped with any suitable ink and tip, including those claimed, without effecting the overall operation of the device, especially since the Applicant has not placed any criticality on these features and discloses that any suitable ink or tip may be employed by the instant invention. In regard to claims 5 and 16, although the Hoenig reference does not disclose that the light source is an LED, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the Hoenig device can be equipped with any suitable light source, including an LED, without effecting the overall operation of the device, especially since the Applicant has not placed any criticality on the particular type of light source and discloses that any suitable light source may be employed by the instant invention.

Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoenig in view of Wang (as cited by the Applicant). Although the Hoenig device does not include advertising indicia thereon, attention is directed to the Wang reference, which discloses another illuminated writing pen wherein advertising indicia is provided thereon (see column 2, lines 35-36) in order to enable the writing instrument to be used for advertising purposes. Accordingly, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to include such advertising into the Hoenig device in order to enable the device to be used for advertising purposes.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
5/17/06